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Anne O'Malley

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EXAMINER

NGUYEN, HIEP VAN

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/608,792	Applicant(s) O'MALLEY ET AL.	
	Examiner HIEP NGUYEN	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. Claims 1-25 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli (US. 5,842,178) in view of Zalewski et al. (US 6,771,981.)
4. With respect to Claim 1, Giovannoli teaches a system for membership enrollment comprising:
 - a. an enrollment system including an enrollment system server for processing data in connection with a user ("178; col. 4, lines 4-7);
 - b. a first supplier system for providing a first membership indicia to said enrollment system in response to said user data ('178; Col. /lines 4/64-5/11; Also see Fig. 7 for buyers' registration);
 - c. a second supplier system for providing a second membership indicia to said enrollment system in response to said user data, said second membership

indicia different from said first membership indicia ('178; Col4, lines 53-63; Also see Fig. 7 for vendors' registration)

Giovannoli does not disclose clearly:

- d. a readable storage device including a database for storing said first and second membership indicia, and said user data;
- e. an enrollment system reader in communication with said readable storage device and said enrollment system server, said reader receiving said user data .

However, Zalewski et al. discloses a readable storage device including a database for storing said first and second membership indicia, and said user data; and an enrollment system reader in communication with said readable storage device and said enrollment system server, said reader receiving said user data ('981; Col. 7, lines 14-20; Col. 8, lines 13-19, 49-56.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the requests for quotation' system of Giovannoli ('178; Abstract) the use of an electronic device of a transponder as taught by Zalewski et al. ('981; Abstract) for providing local data transfer.

Claim 12 is rejected as the same reason with Claim 1.

5. With respect to Claim 2, the combined art teaches a system according to claim 1. Zalewski et al. discloses wherein said reader is in communication with said enrollment system for providing said user data to said first and second suppliers ('981; Col. 7, lines 14-20).

Claim 13 is rejected as the same reason with Claim 2.

6. With respect to Claim 3, the combined art teaches system according to claim 1. Giovannoli discloses wherein said enrollment system server provides said first and second membership indicia to said readable storage device, said readable storage device storing said first and second membership indicia in said readable storage device database (178; Col. 5, lines 5-11; Col. 6, lines 12-14).

Claim 14 is rejected as the same reason with Claim 3.

7. With respect to Claim 4, the combined art teaches a system according to claim 3. Zalewski et al. discloses wherein said readable storage device database further includes a rewards data file for storing rewards value ('981; col. 9, lines 10-12).

Claim 15 is rejected as the same reason with Claim 4.

8. With respect to Claim 5, the combined art teaches a system according to claim 4. Zalewski et al. discloses further including a first supplier reader and a second supplier reader, said first and second supplier readers in communication with said enrollment system, said first and second supplier readers for providing said interrogation signal and receiving at least one of said first and second membership indicia ('981; Col. 8, lines 16-21).

9. With respect to Claim 6, the combined art teaches a system according to claim 5. Zalewski et al. discloses wherein at least one of said first and second supplier systems provides value to said rewards data file ('981; Col. 11, lines 62-67).

Claim 16 is rejected as the same reason with Claim 6.

10. With respect to Claims 7 and 8, the combined art teaches a system according to claim 6. Zalewski et al. discloses wherein said value is provided in accordance with said user data, and wherein said value is provided in response to receipt of said user data ('981; col./lines 11/62-12/13).

Claim 17 is rejected as the same reason with Claims 7 and 8.

11. With respect to Claim 9, the combined art teaches a system according to claim 3. Giovannoli discloses wherein said readable storage device stores said first membership indicia prior to storing said second membership indicia ('178; Col. 5, lines 5-11; Col. 6, lines 12-14).

Claim 18 is rejected as the same reason with Claim 9.

12. With respect to Claim 10, the combined art teaches a system according to claim 3. Giovannoli discloses wherein said readable storage device stores said first and second membership indicia substantially simultaneously ('178; Col. 5, lines 5-11; Col. 6, lines 12-14).

Claim 19 is rejected as the same reason with Claim 10.

13. With respect to Claim 11, the combined art teaches a system according to claim 3. Giovannoli discloses wherein said readable storage device stores at least one of said first and second membership indicia automatically ('178; Col. 5, lines 5-11; Col. 6, lines 12-14).

Claim 20 is rejected as the same reason with Claim 11.

14. Claim 21 is rejected as the same reason with Claim 1.

15. With respect to Claim 22, , the combined art teaches a method according to claim 21:

Zalewski et al. discloses further comprising:

receiving at least one of the unique membership numbers from the storage device upon presentation of the device to a first service provider, the unique membership number identifying the user as a member of a first service provider membership program and authenticating authenticity of at least the membership number and user ('981; Col. 7, lines 14-20; col 11, lines 39-53);

providing rewards points to the storage device in accordance with at least one of the unique membership number and a transaction indicia; and providing means for storing the rewards points for later redemption ('981; Col./line 11/62-12/13).

16. Claim 24 is rejected as the same reason with claim 21.

17. Claim 23 is rejected as the same reason with claim 12.

18. With respect to Claim 25, the combined art teaches a method according to 24.

Zalewski et al. discloses wherein the transfer of at least one of said rewards points, user specific data, and unique membership number is via RF ('981; Col. 8, lines 40-56).

Response to Arguments

19. Applicant's arguments filed 07/13/2009 have been fully considered but they are not persuasive.

20. In the Remarks filed 07/13/2009, the Applicant argued that the teachings of Giovannoli does not concern providing a system for membership enrollment of a particular buyer with a plurality of suppliers, nor providing a plurality of membership indicia from the vendors in response to the buyer's data, nor providing for any particular relation between buyers and vendors as described in claims 1, 12, 21, and 23.

21. In response to the Applicant's argument, the Examiner respectfully disagrees the inaction of the Giovanoli's teachings on the part of a system for membership enrollment as described in the Applicant's invention. In fact Giovannoli discloses a network member is anyone or any company which has registered as a user by completing an application and can be a buyer and/or a vendor in using the services ('178; Col. 4, lines 4-7). New vendor may apply for membership using the quotation system's World Wide Web application. Buyer members would access the same system and apply for membership or request price quotation ('178; Col. 4, lines 52-63). Giovannoli discloses in Fig 7B the description of "the sample buyers data packet and Vendor adds to the data packet" with the connection between the buyers and vendors (or plurality of vendors); and further, routing to the specified class of vendors. The number of vendors within the specified class will depend on the buyer class specification. (e.g. vendors' indicia) ('178;

Col. 7, lines 3-34). Thus Giovannoli discloses the relationship between buyers and vendors.

Therefore, given the broadest reasonable interpretation to one of ordinary skill in the art, it is submitted that the registration of membership for buyers and vendors in the teachings of Giovannoli is in a form of membership enrollment' system described as in the Applicant's invention.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, the Examiner maintains the rejection to Applicant's claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571) 270-5211. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

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/H. N./

Examiner, Art Unit 3686

October 23, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686